

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:	Takagi et al.	Docket No.:	AM100246-00
Serial No.:	10/019,481	Confirmation No.:	1417
Filing Date:	4/4/2002	Examiner:	LEVY, NEIL S
Customer No.:	26474	Art Unit:	1615

For: Ant controllers and method for application thereof

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the outstanding rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reasons stated on the attached sheets.

Please note that the non-final Office action mailed August 22, 2007, has been mislabeled on the USPTO PAIR website as a restriction requirement.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account 14.1437. Please credit any excess fees to such account.

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Arguments

Claims 1, 10, and 13 – 47 stand rejected under 35 U.S.C. §102 (a) and (e) over *Treacy et al.* (US 6,342,578). Anticipation under 35 U.S.C. §102 can be found only if a reference shows *exactly* what is claimed.¹ The fact that claimed subject matter may be encompassed by a generic disclosure does not by itself establish obviousness of the claimed subject matter.²

The teaching of *Treacy et al.* addresses an insecticidal composition³ which comprises synergistically effective amounts of a neuronal sodium channel antagonist which *inter alia* encompasses compounds as represented by applicants' formula (I-1), and an arylpyrrole. *Treacy et al.* provide that this binary composition is effective against a wide variety of lepidopteran and coleopteran insects such as cotton bollworm, tobacco budworm, potato beetle and corn rootworm and the like.⁴ However, *Treacy et al.* merely contemplate the possibility that their synergistic binary composition itself “may be useful”⁵ to control cockroaches, ants, termites or the like. Thus, *Treacy et al.* fail to show the claimed invention.

Column 7, lines 32 -35 of *Treacy et al.* state that “*the composition of the invention may be useful in the prevention and control of public health pests such as houseflies, mosquitoes, cockroaches, ants, termites or the like (emphasis added).*” Apparently it is not needless to say that the phrase, “the composition of the invention,” refers to the combination of (1) neuronal sodium channel antagonist and (2) arylpyrrole insecticide. The cited phrase does not refer to the composition utilized in Applicants' invention.

The claims of Applicants' application require the utilization of an effective amount of the hydrazine compound of formula (I-1), itself. This specific compound is merely included, *inter alia*, in *Treacy et al.*'s disclosure of a neuronal sodium channel antagonist, which generically discloses a huge spectrum of compounds. Thus, while *Treacy et al.* provides for effective amounts of the binary composition, Applicants'

¹ Cf. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

² Cf. *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994).

³ Col. 1, indicated lines 61 to 67, of US 6,342,518.

⁴ Col. 7, indicated lines 26 to 31, of US 6,342,518.

⁵ Col. 7, indicated line 32, of US 6,342,518.

claims call for effective amounts of the specific compound of formula (I-1), itself. As such, *Treacy et al.* clearly fails to identically describe the respective element of Applicants' claims.

Moreover, *Treacy et al.* do not disclose that their binary composition "was used to control Cockroach [*sic*], ants, termites or the like"⁶ as maintained by the Examiner. Instead, *Treacy et al.* merely state that their binary composition *may be useful* for those purposes. At no time do *Treacy et al.* disclose the utilization of an effective amount of a hydrazine compound of formula (I-1) to control the specific pests required by the present claims.

Thus, the Examiner's argument that "the Treacy disclosure is no better/no worse than applicant's"⁷ is inappropriate. The Examiner simply has not applied the appropriate legal standard. *Treacy et al.* cannot reasonably be regarded as showing the *identical invention* in as complete detail as is contained in applicants' claims.

Claims 1, 10, 13 – 47 stand rejected under 35 U.S.C §103(a) over Stefferud⁸ in view of Takagi et al. This rejection is in error, because "[t]o establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest all the claim limitations."⁹

The cited references fail to teach or suggest all the limitations of claim 1, because the cited references do not teach a method for controlling a pest selected from the Isoptera, Hymenoptera, Orthoptera and Psocoptera orders which comprises applying to said pest or to a wooden part or to soil in the habitat of said pest an effective amount of a hydrazine compound of formula (I-1).

The cited references fail to teach or suggest all the limitations of claim 15, because the cited references do not teach a method for protecting houses or an article selected from construction materials, furniture, leather, fibers, vinyl articles, electronic wires and cables against a pest selected from the Rhinotermitidae, Termitidae, Kalotermitidae and Termopsidae families, which comprises applying an effective amount of a hydrazine compound of formula (I-1) ... to said pest, a habitat or a nest of said pest,

⁶ Page 4 of the non-final Office Action of June 11, 2004 at lines 13 – 14.

⁷ Page 2 of the Final Office Action of July 3, 2006, at lines 7 – 8.

⁸ Stefferud, ed., INSECTS – the year book of agriculture, p 469, (1952).

⁹ MPEP §2143.

to a place at which occurrence of said pest is expected or to the article.

The cited references fail to teach or suggest all the limitations of claim 16, because the cited references do not teach a method for controlling a pest from the Formicidae family in crops, which comprises applying an effective amount of a hydrazine compound of formula (I-1) ... to said pest, to said crops, to soil surrounding said crops or to a nest of said pest.

The Examiner has alleged that the limitations of these claims are inherently disclosed by *Takagi et al.*, however as discussed above, the alleged inherency has not been established. The claim limitations do not necessarily flow from the teachings of *Takagi et al.*

Of course, the Examiner has also cited *Stefferd*, to allege that it provides a definition of the term “household insects.” According to the Examiner, *Stefferd*’s definition of “household insects” includes “termites, ants, ... beetles, such as powder post beetles, ... lice, mites, [and] flies which damage buildings and wood furniture, clothing, rugs, [and] upholstery.”¹⁰ Assuming for the sake of argument that the Examiner’s interpretation of *Stefferd* is accurate, the reference, at best, teaches that many types of insects could be labeled as “household insects.” Next, the Examiner assumes that *Stefferd*’s “household insects” would probably be in the locations where the *Takagi et al.* formulation is to be applied, i.e., “trees, fields, inside of houses & ditches around houses.” Again, “[i]nherency ... may not be established by probabilities or possibilities.”¹¹ Any conclusion that the *Takagi et al.* method would inherently be effective against the “household insects” listed by *Stefferd* is in error. Indeed, it should be readily apparent that a specific insecticide is not necessarily effective against all insects that can possibly or would probably occur in a given location. For at least these reasons, the present rejection is in clear error.

Claims 1, 10, 13 – 47 stand rejected under 35 U.S.C §103(a) over *Treacy et al.* in view of *Takagi et al.* and *Stefferd*. The teaching of *Treacy et al.* addresses an insecticidal composition¹² which comprises synergistically effective amounts of a neuronal sodium channel antagonist which *inter alia* encompasses compounds as

¹⁰ Page 3, lines 32 – 34 of the present Office action.

¹¹ In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

¹² Cf. col. 1, indicated lines 61 to 67, of US 6,342,518.

represented by applicants' formula (I-1), and an arylpyrrole. *Treacy et al.* provide that this binary composition is effective against a wide variety of lepidopteran and coleopteran insects such as cotton bollworm, tobacco budworm, potato beetle and corn rootworm and the like.¹³ However, *Treacy et al.* merely contemplate the possibility that their synergistic binary composition itself "may be useful"¹⁴ to control cockroaches, ants, termites or the like. Thus, *Treacy et al.* fail to show: a method, as claimed in claim 1, for controlling a pest selected from the *Isoptera*, *Hymenoptera*, *Orthoptera* and *Psocoptera* orders which comprises applying to said pest or to a wooden part or to soil in the habitat of said pest an effective amount of a certain hydrazine compound as is represented by applicants' formula (I-1) which specifically requires for Y being 1 to 5 of the same or different substituents selected from the group consisting of nitro and cyano;¹⁵ a method, as claimed in claim 15, for protecting houses or an article selected from construction materials, furniture, leather, fibers, vinyl articles, electronic wires and cables against a pest selected from the Rhinotermitidae, Termitidae, Kalotermitidae and Termopsidae families, which comprises applying an effective amount of a hydrazine compound of formula (I-1) which specifically requires for Y being 1 to 5 of the same or different substituents selected from the group consisting of nitro and cyano, to said pest, a habitat or a nest of said pest, to a place at which occurrence of said pest is expected or to the article;¹⁶ or a method, as claimed in claim 16, for controlling a pest from the *Formicidae* family in crops, which comprises applying an effective amount of a certain hydrazine compound as is represented by applicants' formula (I-1) which specifically requires for Y being 1 to 5 of the same or different substituents selected from the group consisting of nitro and cyano, to said pest, to said crops, to soil surrounding said crops or to a nest of said pest.¹⁷

The Examiner's proposed combination with the teachings of *Takagi et al.* and *Stefferd* fail to compensate for these shortcomings. The *Takagi et al.* reference shares the shortcomings of *Treacy et al.* and, as discussed above, *Stefferd* cannot be used to

¹³ Cf. col. 7, indicated lines 26 to 31, of US 6,342,518.

¹⁴ Cf. col. 7, indicated line 32, of US 6,342,518.

¹⁵ Cf. applicants' Claims 1, 10, 13 and 14. Cf. also applicants' new Claims 18 to 27 which depend upon Claim 1.

¹⁶ Cf. applicants' Claim 15 also applicants' new Claims 38 to 47 which depend upon Claim 15.

¹⁷ Cf. applicants' Claims 16 and 17. Cf. also applicants' new Claims 38 to 47 which depend upon Claim 16.

establish the inherency of the present invention, because contrary to the Examiner's implicit assertion, a specific insecticide is not necessarily effective against all insects that can possibly or would probably occur in a given location.

In Conclusion:

The rejections are based on clear errors. Little, if any, interpretation of the claims or the references is required to conclude that the rejections should be withdrawn. The present application is in condition for allowance. Favorable action is respectfully requested. In order to facilitate the resolution of any issues or questions presented by this paper, please feel free to contact the undersigned by phone to further the discussion.

NOVAK DRUCE & QUIGG, LLP
1300 Eye St. N.W.
Suite 1000 West
Washington, D.C. 20005

Phone: (202) 659-0100
Fax: (202) 659-0105

Respectfully submitted,
NOVAK DRUCE & QUIGG, LLP

A handwritten signature in black ink, appearing to read "Michael P. Byrne".

Michael P. Byrne
Registration No.: 54,015